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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,612	04/02/2001	Eric M. Peters	OMN.P.US0001	1072

7590 05/30/2003

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EXAMINER

VO, HAI

ART UNIT	PAPER NUMBER
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1771

6

DATE MAILED: 05/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

A26

Office Action Summary

Application No.

09/824,612

Applicant(s)

PETERS, ERIC M.

Examiner

Hai Vo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 16-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 03/03/2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15, drawn to a retroreflective article, classified in class 428, subclass 315.7.
- II. Claims 16-25, drawn to a method for the production of a retroreflective article, classified in class 427, subclass various.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the process as claimed can be used to make other and materially different product such as one that has a substrate having a pore diameter greater than 0.5 micron.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Donald Bobak on 11/11/2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-15. Affirmation of this election must be made by applicant in replying to this Office

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action. Claims 16-25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

4. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 03/03/2003 have been accepted. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-10, and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lasch et al (US 5,082,715) in view of Morris et al (US 5,673,148) substantially as set forth in Paper no. 3.
7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lasch et al (US 5,082,715) in view of Morris et al (US 5,673,148) as applied to claim 1 above, further in view of Walter (US 5,660,768) substantially as set forth in Paper no. 3.

Response to Arguments

8. The examiner absolutely agrees that the reasons stated in Paper no. 3 why the inventions of Groups I and II are distinct are insufficient and improper. However, the inventions are distinct because the process as claimed can be used to make other

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and materially different product such as one that has a substrate having a pore diameter greater than 0.5 micron. Applicant reserves the right to request rejoinder of the method claims with the product claims upon indication of the product claims as being allowable.

9. The 102 art rejections have been overcome by the present amendment.
10. Applicant's arguments filed 03/03/2003 have been fully considered but they are not persuasive.
11. The 103 art rejections have been maintained for the following reasons. The claim language "the reflective coating is located on the surface of the substrate" does not necessarily mean the reflective coating directly in contact with the surface of the substrate. Therefore, Lasch as modified by Morris still suggests the claimed subject matter. Lasch discloses a conformable marking for road markings comprising a microporous thermoplastic polymer base layer having an adhesive layer on the bottom surface and a retroreflective material imbedded into the top layer adhered to the top surface of the base (column 9, lines 45-60). Lasch teaches using transparent microspheres for retroreflectivity, but does not specifically teach using metal or dielectric coatings such as aluminum. Morris discloses retroreflective elements comprised of transparent microspheres having a coating of aluminum on a hemispherical surface of the microsphere (column 4, lines 19-22). The combination of Lasch and Morris clearly teaches a conformable marking comprising a microporous thermoplastic polymer base layer, a top layer adhered to the base layer wherein the top layer having microspheres embedded therein wherein each

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microsphere have a coating of aluminum on its hemispherical surface. Likewise, it is clearly apparent that the aluminum coating partially obscures a plurality of the pores of the substrate set out in the claims. Applicant needs to be specific about the relative position of the reflective coating and the substrate in a retroreflective article in order to overcome the finding of obviousness.

Conclusion

12. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

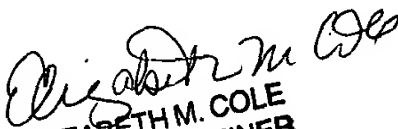
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Tue-Fri, 8:30-6:00 and on alternating Mondays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV
May 28, 2003


ELIZABETH M. COLE
PRIMARY EXAMINER